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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,379	02/28/2002	Hiroshi Itoh	JP920000402US1	6562

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EXAMINER
PIERRE, MYRIAM

ART UNIT	PAPER NUMBER
2654	

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/085,379	ITOH ET AL.
	Examiner	Art Unit
	Myriam Pierre	2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 December 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☒ Certified copies of the priority documents have been received in Application No. <u>2001-59031</u>.

        3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/02/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Morimoto et al. (6,789,057) teach Internet search engines (col. 14 lines 53-60 and Fig. 18) and Morimoto et al. already teach the translation aspect. Smith III teaches a dictionary server which relates to links (Figs. 1-5), in order to have editorial control thus avoiding the result of directory websites that tend to offer far less information relative to the index websites (col. 5 lines 50-55 and col. 2 lines 14-16).

In response to applicant's argument that Morimoto et al. and Smith III are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Morimoto et al. teach a dictionary management system which utilities dictionary servers and Smith III teaches management hyperlinks on the internet in order to provide a predetermined Internet search

engine in which unknown words (col. 6 lines 24-30) can be retrieved (col. 9 lines 57-63 and col.

19 lines 45-53 and 57-60 and Figs. 1-5).

Applicant argues that Smith III does not teach unknown words. Examiner respectfully

disagrees. Smith III does teach unknown words that are retrieved via a dictionary (col. 6 lines

24-30) in order to find the definition of the "unknown" word.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al.

(6,789,057) in view of Smith III (6,772,139).

As to claims 1 Morimoto et al. teach

a translated text creator (document translated, col. 14 lines 61-64 and Fig. 18) for creating

a translated text in which an original text in a first language is translated into said translated text

in a second language (col. 5 lines 57-67) while an unknown word not registered in at least one

dictionary is left in said first language (col. 14 lines 53-60 and Fig. 18 unknown word "latch");

a translated text display for displaying said translated text created by said translated text

creator (Fig. 18);

said unknown word in said first language in said translated text displayed by said display

(Fig. 26) for which an instruction is provided (classification pointers, col. 16 lines 23-33) such

that a search for said unknown word in said first language is conducted using said unknown word

as a search word (Fig. 19 and col. 16 lines 23-33).

Morimoto et al. suggests Internet search engines (dictionary server ID, Internet Protocol

(IP) address, dictionary entry "big blue", col. 14 lines 53-60 and Fig. 18) but do not explicitly

teach a predetermined Internet search engine.

However, Smith III teaches a predetermined Internet search engine based on first

language (col. 9 lines 57-63 and col. 19 lines 45-53 and 57-60 and Figs. 1-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Morimoto's translation of unknown words via dictionary servers into

Smith's predetermined Internet search engine to allow users to add or edit link database in order

for users to have editorial control thus avoiding the result of directory websites which tend to

offer far less information relative to the index websites, as taught by Smith III (col. 5 lines 50-55

and col. 2 lines 14-16).

However, Morimoto et al. do not explicitly teach a link setter.

However, Smith III does teach a link setter (Fig. 7 and col. 9 lines 57-63 and col. 19 lines

45-53; link setter for unknown words, alternate language selection, "link free" means the

unknown word or phrase is not set up yet);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Morimoto's system which processes unknown word translation with Smith's

updatable hypertext link system to create a link setter because a user can install information to be

indexed without waiting for a spider to find it (spiders are indexes updated automatically, Smith

III, col. 1 lines 34-39.

Claim 9 is directed toward a machine translation to implement or execute the method of

claim 1, and is similar in scope and content of claim 1, therefore, claim 9 is rejected under

similar rationale.

Claim 17 is directed toward a machine translation program with computer readable

program code to implement or execute the method of claim 1, and is similar in scope and content

of claim 1, therefore, claim 17 is rejected under similar rationale.

As to claims 2, 10, and 18, which depend on claims 1, 9, and 17, Morimoto et al. teach

a field detector (pointer classification designates server dictionary, col. 16 lines 23-25)

for detecting a field relevant to a subject matter of said original text (col. 13 lines 9-13), said

unknown word in said first language so as to search for said unknown word in one of plurality of

search fields of (suggested) Internet search engine (URL corresponding to dictionary

information, col. 16 lines 29-33; col. 5 lines 57-67) which corresponds to said field detected by

said field detector (pointer classification)(pointer classification designates the server dictionary,

col. 16 lines 23-33).

Morimoto et al. do not explicitly teach a link setter.

However, Smith III does teach a link setter (Fig. 7 and col. 9 lines 57-63 and col. 19 lines

45-53 and 57-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Morimoto's method of managing bilingual dictionaries distributed on a

network, a widespread of an internet, with Smith's updatable hypertext link system because

Smith III teaches that this would provide a user friendly linking system, thus developers may add

their own link and create new links as the system needs to be updated, col. 3 lines 62-65 and col.

4 lines 9-11 and 14-20.

As to claims 3, 11, and 19, which depend on claims 2, 10, and 18, Morimoto et al. teach

Morimoto et al. suggest Internet search engines used for searching for said unknown ·

word for each of said fields detected by said field detector (col. 16 lines 23-33 and col. 19 lines

45-53).

Morimoto et al. do not explicitly teach a link setter storing settings about internet search

engine.

However, Smith III does teach

link setter stores settings about said Internet search engine which are to be used for

searching for said unknown word for each of said fields detected by said field detector (Fig. 7

and col. 14 lines 24-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Morimoto et al.'s method of managing bilingual dictionaries distributed on a

network, a widespread of an internet, with Smith's updatable hypertext link system, because

Smith III teaches that this would provide allow users to save or store settings about the search

engine used for searching unknown words for future retrieval, col. 14 lines 24-43; col. 3 lines 62-

65 and col. 4 lines 9-11 and 14-20.

As to claims 4, 12, and 20, which depend on claims 2, 10, and 17, Morimoto et al. teach

a translation word registrar for generating a translation word registration screen which

allows said user to edit and register a translation word for said unknown word (fig. 19), and for

registering and translation word in said at least one dictionary (Fig. 20), in association with said

field relevant to said subject matter of said original text which contains said unknown word (Fig.

7 step 27 and col. 14 lines 53-60 and Fig. 18).

unknown word as found by said Internet search engine in response to said instruction

given by a user for executing said search for said unknown word (col. 16 lines 23-33 and col. 19

lines 45-53).

Morimoto et al. do not explicitly teach displaying a list of search results set by link setter.

However, Smith III does teach

a search result list display for displaying a search result list of Web pages relevant to said

unknown word as found by said Internet search engine in response to said instruction given by a

user for executing said search for said unknown word for which said link has been set by said

link setter (Fig. 7, element 170 and col. 19 lines 45-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Morimoto et al.'s method of managing bilingual dictionaries distributed on a

network, a widespread of an internet, with Smith III's list display because Smith III teaches that

this would provide access to updatable information, Fig. 7 and col. 14 lines 24-43; col. 3 lines

62-65 and col. 4 lines 9-11 and 14-20.

Morimoto teach unknown word related to Web page (Fig. 10, element 307 and Fig. 14)

does not explicitly teach an displaying Web page which has been selected from said user.

However, Smith III does suggest an unknown word related Web page display for

displaying a Web page which has been selected from search result list by said user (col. 3 lines

18-25 and col. 19 lines 45-53 and col. 6 lines 24-29).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Morimoto et al.'s method of managing bilingual dictionaries distributed on a

network, a widespread of an internet, with Smith III's display of Web pages to create the display

of a related Web page for displaying a page resulting from a user search because Smith III

teaches that this would provide much easier for the user to explore the web by visiting Web

pages and clicking on the links found therein, col. 3 lines 21-24.

As to claims 5, 13, and 21, which depend on claims 1, 9, and 16, Morimoto et al. suggests

a search engine changer (Fig. 1, element 1).

Morimoto et al. do not explicitly teach the search engine changer set by link setter.

However Smith III does teach

a search engine changer for changing said Internet search engine to which said link is set

by said link setter (col. 3 lines 49-51 and col. 26 lines 1-47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Morimoto's search engine changer with Smith's search changer via a link

setter because Smith III teaches that this would provide flexibility, thus allowing the user the ·

option of updating links, col. 14 lines 24-43; col. 3 lines 62-65 and col. 4 lines 9-11 and 14-20.

As to claims 6, 14, and 22, which depend on claims 1, 9, and 16, Morimoto et al. teach

a translation word registrar for generating a translation word registration screen which allows said user to edit and register a translation word for said unknown word (Fig. 4 step 14), and for registering said translation word for said unknown word in said at least one dictionary (Fig. 6 step 16)

Morimoto et al. do not explicitly teach Web pages relevant to unknown words.

However, Smith III does teach

a search result list display for displaying a search result list of Web pages relevant to said unknown word as found by said Internet search engine in response to said instruction given by a user for executing said search for said unknown word for which said link has been set by said link setter (col. 26 lines 1-47 and Fig. 7 element 77 and col. 19 lines 48-53, the link-free unknown word is not set up yet)

an unknown word related Web page display for displaying a Web page which has been selected from said search result list by said user; (col. 26 lines 1-47 and col. 19 lines 48-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Morimoto's method of managing bilingual dictionaries distributed on a network, a widespread of an internet, with Smith's Web page link setter system, because Smith III teaches that this would provide search results for unknown words using Web pages for user flexibility, thus the searches can be honed rather finely without relying entirely on typical means for selecting a subset of all names and phrases within contexts, key-phrases, and definitions, col. 11 lines 63-67.

As to claims 7, 15, and 23, which depend on claims 6, 14, and 22, Morimoto et al. teach

an unknown word translated into second language (Fig. 18).

Morimoto et al. do not teach an unknown word related to Web page translator, displaying unknown word related to Web page display in second language.

However, Smith III does teach

an unknown word related Web page translator for translating said Web page displayed by said unknown word related Web page display (unrecognized words or phases maybe forwarded to internet search engine), into said second language (alternate language for web page)(col. 9 lines 8-63 and col. 19 lines and col. 6 lines 24-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Morimoto et al.'s method of managing bilingual dictionaries distributed on a network, a widespread of an internet, with Smith III's online translatable web pages because Smith III teaches that this would provide user control, thus user can control what is being displayed via additional optional properties, which includes the language content, col. 14 lines 24-43; col. 4 lines 14-20; col. 3 lines 62-65 and col. 4 lines 9-11 and 14-20).

As to claims 8, 16, and 24, which depend on claims 6, 14, and 22, Morimoto et al. teach translation and registering translated words for unknown word (Fig. 18).

a re-translation controller for instructing re-translation of said original text containing said unknown word after said translation word registrar has performed registration of said translation word for said unknown word (Fig. 16 step 413 and col. 18 lines 55-60).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. See PTO-892.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

6. Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Myriam Pierre whose telephone number is 571-272-7611.

The examiner can normally be reached on Monday - Friday from 5:30 a.m. - 2:00p.m.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Richemond Dorvil can be reached on (571) 272-7602. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information as to the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MP   02/12/2006

RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER